

Response to Office Action Dated March 10, 2005
U.S. Patent Application No. 09/932,213
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REMARKS

Summary of the Office Action

1. Claim 41 stands rejected under 35 U.S.C. Section 102(e) as being anticipated by Boesen (U.S. Patent No. 6,542,721).
2. Claim 44 stands rejected under 35 U.S.C. Section 103(a) as being rendered obvious by Boesen
3. Claims 1, 3, 22, 24-40 and 45-50 stand rejected under 35 U.S.C. 103(a) as being rendered obvious over Boesen.

Summary of the Response

Applicant has amended Claim 1, 19, 27, 41 and 45.
Now pending are claims 1-50.

Detailed Remarks

Applicant requests consideration of the following remarks.

1. Claim 41 stands rejected under 35 U.S.C. Section 102(e) as being anticipated by Boesen (U.S. Patent No. 6,542,721)

A. Legal Standard for Anticipation

Under 35 U.S.C. 102, the USPTO bears the burden of presenting a prima facie case of anticipation. This burden means that the prior art cited against Applicant must disclose, either expressly or through principles of inherency, each and every element of the claimed invention.

Additionally, "the prior art reference must be enabling." *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, at 1479, 1 USPQ2d 1241, at 1245(Federal Circuit). "Furthermore, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it." *In re Donohue*, 766 F.2d 531, 533; 226 USPQ 619, at 621 (Federal Circuit). As recited by the Federal Circuit, "such possession is effected if one of ordinary skill in the art could have

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combined the publication's description of the invention with his own knowledge to make the claimed invention." *Id.*

B. Application of the Standard

Regarding Claim 41, the Examiner asserts that Boesen teaches that the first segment that moves between a contracted position and an extended position primarily along one axis. Applicant believes this is not the case. Applicant concurs that Boesen teaches (i) two segments of an electronic device that are connected to extend between extended and contracted positions, and (ii) that in the extended position, the two segments align primarily along one axis.

However, Applicant disagrees that Boesen teaches "a second segment slideably coupled to the first segment to move primarily along one axis... between a contracted position and an extended position," as recited by the pending claims, including by Claim 41. Boesen teaches that in the extended position, the first segment and the second segment are aligned linearly, but in order to arrive at that position, the second segment has to pivot about an end that is adjacent to the first segment. This pivot means that the movement is not in one direction. While Applicant believes that the aforementioned claim language is on its face distinguishable from Boesen, Applicant has added the limitation "without pivoting" as a limitation of the movement of the second segment with respect to the first segment. The result of the aforementioned arguments is that the trajectory of any point on the second segment is primarily linear, not parabolic as taught by Boesen.

Applicant also concedes that Boesen teaches use of "slide hinges, lateral hinges, collapsible hinges, slide joints, lateral joints or similar mechanisms" as the coupling mechanism between the second segment and the first segment. [Column 5, lines 63-65]. However, this is not a teaching of the non-pivoting, one directional movement as provided for in Claim 41. Boesen shows, in FIG. 7 for example, a sliding hinge, but the use is to effect a pivot to move its second segment between contracted and extended positions. FIGS. 13-15 of Boesen show the desired effect of any sliding motion between the two segments of that device-it is to place one segment in a tilted and adjacent position against the other segment. As recited by Claim 41, this is not the desired effect of this claimed invention.

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These teachings of Boesen do not meet the legal standard set forth in part A of this section. Specifically, Boesen does not either explicitly or implicitly (through inherency) teach two segments that can move with respect to one another without pivot.

Claims 42-44 depend from Claim 41. For reasons stated above, Applicant believes claim 41, and dependent Claims 42-44, are in condition for allowance.

2. Claim 44 stands rejected under 35 U.S.C. Section 103(a) as being obvious over Boesen.

A. Legal Standard

Section 2143 MPEP summarizes the standard for establishing a *prima facie* case for obviousness. Three basic criteria must be met: (i) there must be some suggestion or motivation to modify the reference to combine reference teachings; (ii) there must be a reasonable expectation of success; and (iii) the prior art reference must teach or suggest all claim limitations.

B. Application of the Standard

Applicant respectfully submits that the Examiner has glossed over the following language of Claim 41: "wherein the second segment *slides over* the reduced section when moving towards the contracted position" (emphasis added). While Boesen may teach that its second segment (i) slides, and (ii) moves over the first segment, Boesen's second segment does not slide over the first segment-it pivots. In any case, the amendment to Claim 41 should further distinguish this claim over Boesen.

In summary, there is no suggestion in Boesen that its teachings can be modified in a manner recited by the claims. All Figures and related specification teach pivot movement of the second segment with respect to first. There is no suggestion to use a non-pivoting sliding movement.

Furthermore, the prior art reference does not teach or suggest all claim limitations. Examiner appears to agree in stating that "obviously, the portion of the first segment being overlaid by the second segment...." Applicant believes that with this statement, the Examiner is making an inherency argument. Applicant notes that Section 2112 of the MPEP lays the standard for inherency: "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary

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skill.”” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicant believes the standard for inherently finding a teaching is clearly not met in this case.

C. Claims 1-40 and 45-50 stand rejected under 35 U.S.C. 103(a) as being rendered obvious over Boesen.

Applicant respectfully requests reconsideration of these rejections given the arguments presented above, and the amendment to the independent claims. The amended claims not include the limitation of “without pivoting”. As explained above, Boesen teaches a second segment that pivots with respect to the first segment. Applicant’s added limitation makes clear that the second segment’s motion with respect to the first motion is linear.

With regard to Claims 8-18, 24-26, 30-37 and 40, the Examiner has clustered the claims and relied on hindsight to issue a blanket rejection of the claims. Applicant requests reconsideration. With regard to the statement that Boesen teaches “a midframe (portion 38), a bottom shell (portion of 24),” Applicant disagrees. A shell is a portion of a housing segment. A midframe joins the housing segments. Portion 38 of Boesen is actually a display, not a layer in between a front shell and a back shell. Applicant notes, for example, that Claim 10 recites a rail is formed in the midframe. By Examiner’s reasoning, this would mean the rail is formed in the display.

With regard to the obviousness rejections, Applicant believes that the Examiner has not met his burden of proof. Not all of the elements of the claim are taught by the cited references. There is no suggestion to modify Boesen to teach the claimed invention. Accordingly, Applicant requests reconsideration and allowance of these claims.

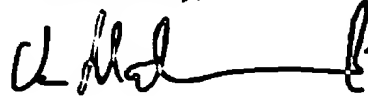
For reasons stated above, Applicant believes the application is in condition for allowance. A Notice of Allowance is respectfully requested.

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CONCLUSION

A Notice of Allowance is respectfully requested. If there are any questions or comments that the Examiner wishes to direct to Applicant's attorney, the Examiner is invited to call Applicant's attorney at (408) 551-6632. The Patent Office is authorized to charge all unpaid fees to the deposit account 50-1914.

Submitted by,



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The undersigned hereby certifies that this paper is being submitted by facsimile transmission to the U.S. Patent Office using fax number 17038729306; or submitted with the U.S. Postal service with sufficient postage as first class mail, addressed to "Mail Stop Non-Fee Amendment, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450" on July 11, 2005.

Signature:



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